

**REMARKS**

Claims 1-26 are pending in the present application. Reconsideration of the application is respectfully requested in view of the following responsive remarks. In the Office Action of January 11, 2006, claims 1-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,507,865 (hereinafter "Yoshida") in view of U.S. Patent No. 5,106,416 (hereinafter "Moffatt").

**Rejections Under 35 U.S.C. § 103**

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The Examiner has rejected claims 1-26 as being obvious over Yoshida in view of Moffatt. As previously set forth, the Yoshida reference is drawn towards an aqueous ink composition that when used in recording, gives a high-quality recorded image having improved image density while preventing the bronzing phenomenon. The aqueous ink compositions taught in Yoshida can include a water-soluble dye, water, and a basic amino acid. Additionally, Yoshida discloses without giving any examples or guidance whatsoever, that "the present invention may further contain, if desired or necessary, other additives such as a wetting agent, a surfactant, a pH regulator, an antiseptic, a mildew-proofing agent, an evaporation accelerator, and a chelating agent." The Examiner has previously stated that Yoshida does not specifically teach an "amphoteric" surfactant. It should be pointed out at this time that not only does Yoshida fail to mention or exemplify the use of an amphoteric surfactant, but also fails to teach the amount of any type of appropriate surfactant that

could be used. In other words, the mentioning of a surfactant in a list of other possible ingredients appears to be more of a throw away or catch-all line of possible ingredients that might be used.

Moffatt teaches ink-jet inks which utilize various types of surfactants to improve the color bleeding of the ink-jet ink. Thus, there is no specific suggestion of using amphoteric surfactants over other types of surfactants. The inks taught in Moffatt can comprise a vehicle, a cationic dye, high boiling point solvent, and one or two amphiphiles surfactant(s) at concentrations above their critical micelle concentration (cmc). (The term “amphiphile” should not be confused with “amphoteric surfactant” as one has to do with hydrophobic/hydrophilic character which all surfactants exhibit and the other has to do with charge wherein within certain pH ranges, both a positive and a negative charge can be present simultaneously). Above the cmc, micelles form, which attract the dye molecule and thus control the color bleed. This is true in Moffatt regardless of whether an amphoteric surfactant or any other type of surfactant is used.

Regarding this combination rejection, speaking of Yoshida, the Examiner has stated in the most recent office action that the term “surfactant” suggests the addition of any surfactant that is typically added to ink compositions. This is an interesting statement, in that though surfactants are “typically” added to inks as alleged by the Examiner, Yoshida does not add any type of surfactant to its working examples, let alone the specialized type of amphoteric surfactant required by the currently claimed invention. Further, it is also noteworthy that the only example in Moffatt which is used to teach the claimed invention is not an amphoteric surfactant, but a non-ionic amphiphile. Thus, though the combination of references has general teachings of the use of amino acids and amphoteric surfactants, neither exemplify the use of an amphoteric surfactant in a working example. Thus, in order to arrive at the claimed invention, one would have to accept the “catch all” suggestion of adding a surfactant from Yoshida, and choose a surfactant for use that is arguably one of the less common types of surfactants in the art. Based on Moffatt, there is no more reason to select an amphoteric surfactant for use than other types of surfactants, such as Surfynol 465, which is the exemplified surfactant.

In short, the Applicant is not claiming to have invented the use of amino acids in inks, nor the use of amphoteric surfactants in inks. The Applicant is claiming to

have discovered that the combination of amphoteric surfactant and amino acid in a black ink-jet ink has desirably properties, particularly on plain paper, and that this combination is patentable over the prior art.

This being said, in order to further distinguish the claimed invention from the combination suggested by the Examiner, the Applicants have amended the claims to require that the amphoteric surfactant be present at from 0.01 wt% to 2 wt% in the liquid vehicle. It should be noted that Yoshida makes no mention as to the amount of surfactant that can be added, and thus, this amendment further distinguishes the claimed invention over the prior art. Reconsideration on these grounds and the grounds previously set forth in the prior office action response is respectfully requested.

### **CONCLUSION**

In view of the foregoing, Applicants believe that claims 1-26 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 11<sup>th</sup> day of April, 2006.

Respectfully submitted,



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